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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,013	06/30/2000	Christopher J. Lasher	103864-1200RI	9950

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EXAMINER

KIM, EUGENE LEE

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/608,013

Applicant(s)

LASHER ET AL.

Examiner

Eugene Kim

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09/31/2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-162 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 148 and 153-155 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-1-16, <sup>25-30</sup>30, 31, 36-44, 49-59, 65-76, 81-115, 121-147, 149-152, 156-162 is/are rejected.
- 7) ☒ Claim(s) 5, 17-20, <sup>4</sup>32-35, 45-48, 60-64, 77-80, 116-120, 163-165 is/are objected to.
- 8) ☐ Claim(s) 12 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***§ 2 Claim Rejections - 35 USC § 103***

1. Claims 1-4, 6-16, ~~25-30~~ 30, 31, 36-44, 49-59, 65-76, 81-115, 121-147, 149 -152, 156-162 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charhut in view of Bailer and Goldberg (#4,672,553).

Charhut et al show an automatic prescription filling method and apparatus that comprises multiple conveyors 24a, b, c that are transporting multiple containers. Charhut et al show labeling means, pick up means, capping means, scanning means and a sorting conveyor means 42. The computer means of Charhut et al process information from the entry list or input means and performs the filling operation accordingly. Since operation is performed dependent upon the entry list input means, this entry list acts an indentifier. A vial or container is filled according to the order automatically wherein no one is needed to manually load or count the pills needed for each order. Charhut shows in figure 7 that filling lines are formed prior to the filling operation by lining up prescriptions in lines 12, 14, 16 in an optimal format. Charhut et al also disclose that control system 80 from computer 70 is used to process the patient entry list to fill each prescription order accordingly. As shown in figure 8, Charhut also uses different vials as indicated by the flow chart box of calculating vial sizes needed for each prescription. Also, Charhut et al show different vial sizes in the figures by elements 26a, b, c with 60cc, 120cc and 250 cc vials. Charhut also shows in figure 8 that the vials are maneuvered in optimal format to the shortest wait. This infers that the bottles/vials are loaded up in a scheduled format for optimal results. Charhut et al

Art Unit: 3721

disclose that conveyor 24 separates the containers and spaces them on the conveyor into a vial filler. Charhut et al also disclose that the filler comprises an automatic tablet control machine (col 3 lines 40+) and the tablets are counted into the vial until filling is complete (col 3 lines 60+). Since Charhut et al show a plurality of filling stations, pills are fully capable of being simultaneously deposited into separate bottles. Charhut et al teach the basic concept of printing labels for each corresponding vial/bottle. The plurality of bottle carriers as claimed are read on carrier means 24a, b, and 24c.

Charhut et al disclose that the vials are separated and stored in bin means 40 which have bar codes (col 5 lines 50+). Therefore, Charhut shows the concept of separating individual prescription orders but does not show a consolidation packaging station, identifier as claimed or literature insert packaging means as claimed. Bailer teaches the basic concept of assembling orders wherein a literature insert is assembled for a particular order and placed into a carton as a consolidated order. Bailer discloses that it is standard to include literature inserts in shipping orders (col 1 lines 10+). Inherently, there is some printing means to form the literature packs to go with the shipping container. Furthermore, as stated supra, Charhut discloses printing particular labels for each corresponding vial. These labels act as an identifier. Goldberg teaches the apparatus and method of having an order assembling apparatus to fill an order wherein a label is machine readable with a sorting conveyor to order assembly locations to the order codes. Goldberg teaches that any package may be delivered to any order assembly location. The location depends on recognition of what that item is as represented by its characterization. This whole system can accommodate a wide range

Art Unit: 3721

of package shapes, proportions and weights (col 8 lines 63+). Goldberg teaches the concept of order registering the items and has order selecting means for selecting respective orders to compare each registered item with a stored item characterization to allocate items to selected orders. Goldberg teaches the concept of identifying orders with items and using the identifying labels to correspond to order codes. Goldberg discloses that a package has the same characterization as the item or items (col 1 lines 65+) inferring that the package may have a plurality of items. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Charhut with a shipping container with a corresponding literature package and identifying means as taught by Bailer and Goldberg respectively to provide for a shipping package with related literature written information or instructions and to make sure the orders are correct/accurate. Regarding radio tags, radio tags are well known in the art as they are marketed by Texas Instruments, Inc and disclosed in applicant's issued patents, such as, pat no. 5660305. Regarding claim 162, the examiner takes official notice that error detections means are known as well as discarding defective products.

2. Applicant's arguments filed 9/31/2002 have been fully considered but they are not persuasive. The examiner first notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In regards to reference Goldberg being applied, the examiner in the last office action indicated that identification means are well known in the art and this reference is being used to teach this concept. Therefore, the addition of this reference in the rejection is deemed proper and the action is made final.

In response to applicant's argument regarding the plurality of bottles in a carrier, the examiner notes that it is held that it is obvious to one of ordinary skill in the art to duplicate parts for a multiplied effect. See St. Regis Paper Co v. Bemis Co, Inc., 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977). In this case, Charhut et al disclose that carriers/bins 40 are matched up with prescriptions and the appropriate or matched up vials are dropped into bins 40 (col 12 lines 25+). Therefore, a plurality of bottles are placed in the carriers as claimed. The bins/carriers can receive more than one vial but Charhut does not specifically disclose placing a plurality of receptacles into each carrier. It appears from the drawings that bins 40 have one receptacle or opening. It would have been obvious to provide multiple receptacles within the bins/carriers of Charhut for a multiplied effect to receive a plurality of bottles. Furthermore, it is well known in the art to compartmentalize carriers to separate products being dispensed into carriers.

In response to applicant's argument regarding the customized literature, the examiner notes that Bailer discloses that literature packs are transferred to respective orders (col 2 lines 27+). This infers that the orders are matched up with the literature packs and read on customized literature. The examiner also notes that it is well known in the art to customize packages as taught by Charhut. In Charhut, each prescription is customized to a particular dosage as well as a customized label that is attached to each

particular vial. The actual product being customized is a matter of design choice by the user.

In regards to what element contains an identifier is also a matter of design choice dependent upon the user. Goldberg is being used to teach the basic concept of using identifiers to check products for accuracy. In Charhut, the orders are checked as shown in figure 21. The identifier in essence is the patient filling list which is in control system 80 and in computer 70. Charhut et al also disclose the use of bar codes on bins as discussed supra. Whether the carrier has an identifier or a literature package or both elements is a matter of design choice dependent upon the user. It is well known in the art to use identifiers to check products for accuracy as discussed in the previous office action.

3. Claims 5, 17-<sup>52</sup>~~28~~<sup>4</sup>, 32-35, 45-48, 60-64, 77-80, 116-120, 163-165 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claim 148 and 153-155 are allowed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


Art Unit: 3721

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Kim whose telephone number is (703)308-1886. The examiner can normally be reached on Tuesday-Friday 7:30 a.m - 6:00 p.m.

The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.



Eugene Kim  
December 10, 2002